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EXAMINER

SORRELL, ERON J

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,572

Applicant(s)

COCHRAN ET AL.

Examiner

Eron J. Sorrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-48, 50-98 and 110-121 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-15, 17-48, 50-98, and 110-121 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1,2,4-6,11-23,25-27,30,31,33,35,36,41-53,59-69,75-80,83-85,89-93, and 110-121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reichmeyer et al. (U.S. Patent No. 6,286,038 hereinafter "Reichmeyer") in view of Hamner et al. (U.S. Patent No. 6,076,106 hereinafter "Hamner") and further in view of Watanabe (US Pub. No. 2002/0062364).

3. Referring to method claims 1,31,33, and 48 Reichmeyer teaches a method for configuring a computing device coupled to a network, comprising the acts of:

discovering a computing device (see lines paragraph bridging columns 6 and 7; note the central configuration server passively discovers devices on the network by receiving identification information therefrom.

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identifying a computing device (see lines 26-47 of column 1); and

remotely configuring network parameters of the computing device based on the identification (see lines 26-47 of column 1).

Reichmeyer fails to teach the limitation of actively electronically discovering the computing device and wherein the identifying comprises initiating a sensory identification event to identify the computing device.

Hamner teaches, in an analogous system, actively electronically discovering the computing device (see paragraph bridging columns 5 and 6; note the discovery manager polls the network to find devices different types of devices, this polling step is actively electronically discovering devices on the network).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Reichmeyer with the above teachings of Hamner. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to gather network information automatically at predetermined intervals or at the request of a user command as and display the network configuration at a

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remote management station as suggested by Hamner (see lines 47-63 of column 3).

Watanabe teaches, in an analogous system, identifying the device comprises initiating a sensory identification event to identify the computing device (see paragraph 55 on page 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Reichmeyer and Hamner with the above teachings of Watanabe. One of ordinary skill would have been motivated to make such modification in order to specifically identify a device at the installation location as suggested by Watanabe (see paragraph 17 on page 1).

4. Referring to claim 2, Hamner teaches the act of electronically locating the computing device comprises the act of monitoring network communications (see paragraph bridging columns 5 and 6).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the teachings of Reichmeyer with the above teachings of Hamner. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to determine if specific new devices have been added to

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the network as suggested by Hamner (see lines 47-63 of column 3).

5. Referring to method claims 4-6, 35, and 36, and system claims 65, 66, 67, 84, and 85 Reichmeyer as modified by Hamner teaches the act of monitoring network communications comprises the act of detecting an address request from the computing device, the act of actively electronically locating the computing device comprises the act of responding to the address request, and the act of responding to the address request comprises the acts of verifying a desired characteristic of the computing device and assigning a network address to the computing device (see Reichmeyer, lines 4-30 of column 4 and paragraph bridging columns 6 and 7, note Hamner discloses actively discovering devices).

6. Referring to method claims 11-15, and system claims 68 and 69, Reichmeyer teaches the act of identifying the computing device comprises the act of discovering a desired device characteristic, the act of discovering the desired device characteristic comprises the act of discovering a device category, the act of discovering the device category comprises the act of discovering a device source, the act of discovering

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the device source comprises the act of discovering a device manufacturer, and the act of discovering the desired device characteristic comprises the act of discovering a device model (see paragraph bridging columns 6 and 7 and lines 18-43 of column 8).

7. Referring to claim 17, Hamner teaches the act of initiating a sensory identification event comprises the act of communicating an identification signal from the computing device to a remote display via the network (see lines 10-24 of column 4).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Reichmeyer with the above teachings of Hamner. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to display the network configuration at a remote management station as suggested by Hamner (see lines 47-63 of column 3).

8. Referring to claim 19, Reichmeyer teaches the act of configuring network parameters of the computing device comprises the act of remotely and automatically configuring the computing

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device using desired network parameters based on the identification of the computing device (see lines 26-47 of column 1).

9. Referring to claims 20-23, Reichmeyer teaches the act of configuring network parameters of the computing device comprises the act of remotely interacting with computing device, wherein the act of remotely interacting with the computing device comprises the act of configuring network addresses for the computing device, wherein the act of remotely interacting with the computing device comprises the act of initiating a remote configuration system for the computing device, and wherein the act of initiating the remote configuration system comprises the act of transmitting a network address to the computing device based on the identification (see lines 26-47 of column 1 and lines 4-30 of column 4).

10. Referring to claims 25-27, 46, and 47 Reichmeyer teaches the act of interacting with the computing device via a remote computing device, the act of managing network addressing via the device configuration program, and the act of accessing a device configuration program via the remote computing device (see lines 26-47 of column 1).

11. Referring to claim 30, Reichmeyer teaches remotely configuring a plurality of the computing devices that have been electronically located and identified (see lines 39-59 of column 5).

12. Referring to claims 41 and 42, Reichmeyer as modified by Hamner teaches the act of actively electronically discovering the desired device comprises the act of discovering a desired device identifier, wherein the act of discovering the desired device identifier comprises the act of discovering a product identifier for the desired device (see paragraph bridging columns 6 and 7 and lines 18-43 of column 8).

13. Referring to claim 43, Reichmeyer teaches the act of remotely configuring operational parameters of the desired device comprises the act of configuring a network address for the desired device (see lines 4-30 of column 4).

14. Referring to claim 44, Reichmeyer teaches the act of remotely configuring operational parameters of the desired device comprises the act of initiating a remote configuration system having a device database adapted to facilitate

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configuration of the desired device (see paragraph bridging columns 4 and 5).

15. Referring to claim 45, Reichmeyer teaches the act of initiating the remote configuration system comprises the act of transmitting a network address to the desired device to facilitate communication with the remote configuration system (see lines 4-30 of column 4).

16. Referring to claim 50, Hamner teaches the act of triggering the sensory identification event comprises the act of transmitting an identification signal between the desired device and a remote interface via the network (see lines 10-24 of column 4).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Reichmeyer with the above teachings of Hamner. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to gather network information automatically at predetermined intervals or at the request of a user command as and display the network configuration at a

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remote management station as suggested by Hamner (see lines 47-63 of column 3).

17. Referring to system claim 51, Reichmeyer teaches a system of configuring a second computing device via a first computing device, wherein the first and second computing devices are communicatively coupled via a network, the system comprising:

a device configuration assembly accessible by the first computing device, comprising: a device discovery assembly adapted for discovering the second computing device on the network (see paragraph bridging columns 4 and 5); and

a device setup assembly adapted for initiating configuration of the second computing device via the network (see paragraph bridging columns 4 and 5).

Reichmeyer fails to teach the limitation of actively electronically discovering the computing device and a device discovery assembly further adapted to facilitate identification of the second device via a sensory identification event.

Hamner teaches, in an analogous system, actively electronically discovering the computing device (see paragraph bridging columns 5 and 6; note the discovery manager polls the network to find devices different types of devices, this polling

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step is actively electronically discovering devices on the network).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Reichmeyer with the above teachings of Hamner. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to gather network information automatically at predetermined intervals or at the request of a user command as and display the network configuration at a remote management station as suggested by Hamner (see lines 47-63 of column 3).

Watanabe teaches, in an analogous system, a device discovery assembly further adapted to facilitate identification of the second device via a sensory identification event (see paragraph 55 on page 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Reichmeyer and Hamner with the above teachings of Watanabe. One of ordinary skill would have been motivated to make such modification in order to specifically identify a device at the installation location as suggested by Watanabe (see paragraph 17 on page 1).

18. Referring to claims 52 and 53, Reichmeyer teaches the first computing device comprises a display and an input device (see item labeled 232 in figure 12) and the second computing device comprises a network device (see lines 26-47 of column 1).

19. Referring to claim 59, Reichmeyer the device configuration assembly is disposed on the first computing device (see item labeled 24 in figure 3).

20. Referring to claims 60-63, Reichmeyer teaches the device discovery assembly comprises a network addressing assembly, wherein the network addressing assembly comprises a network address management server coupled to the network adapted for internally managing network addresses of devices coupled to the network and wherein the network addressing assembly comprises a dynamic address assignment module (see item labeled 52 in figure 3 and paragraph bridging columns 5 and 6).

21. Referring to claim 64, Reichmeyer teaches the device configuration assembly comprises a user interface (see item labeled 56 in figure 3 and paragraph bridging columns 5 and 6).

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22. Referring to system claims 75 and 76, Reichmeyer teaches the device setup assembly comprises a device configuration module adapted to configure operational parameters of the second computing device, wherein the device configuration module comprises a remote configuration module coupled to the network, the remote configuration module comprising device specifications (see lines 26-47 of column 1).

23. Referring to claims 77 and 78, Reichmeyer teaches the device discovery assembly comprises means for discovering the second computing device and wherein the device setup assembly comprises means for configuring the second computing device (see lines 26-47 of column 1).

24. Referring to system claim 79, Reichmeyer teaches a system for remotely configuring a networked computing device, comprising:

a network analysis module adapted to determine a network address of a desired device coupled to a network (see paragraph bridging columns 4 and 5);

a device identification module adapted to identify the desired device based on desired parameters (see paragraph bridging columns 4 and 5); and

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a device configuration module adapted to configure the desired device via the network (see paragraph bridging columns 4 and 5).

Reichmeyer fails to teach the limitation of the device identification module searching for and locating the desired device and to facilitate identification if the desired device via a sensory identification event.

Hamner teaches, in an analogous system, the limitation of the device identification module searching for and locating the desired device (see paragraph bridging columns 5 and 6; note the discovery manager polls the network to find different types of devices, this polling step is actively electronically searches for and locates devices on the network).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the teachings of Reichmeyer with the above teachings of Hamner. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to gather network information automatically at predetermined intervals or at the request of a user command and display the network configuration at a remote terminal for network management as suggested by Hamner (see lines 47-63 of column 3).

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Watanabe teaches, in an analogous system, a device discovery assembly further adapted to facilitate identification of the second device via a sensory identification event (see paragraph 55 on page 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Reichmeyer and Hamner with the above teachings of Watanabe. One of ordinary skill would have been motivated to make such modification in order to specifically identify a device at the installation location as suggested by Watanabe (see paragraph 17 on page 1).

25. Referring to claim 80, Reichmeyer teaches the desired device is a network appliance (see item 60, 62, and 64 in figure 3).

26. Referring to claim 83, Reichmeyer teaches the network analysis module comprises a network analysis program disposed on a memory device and accessible by a computing device coupled to the network (see lines 32-34 of column 2).

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27. Referring to claim 89, Reichmeyer teaches 89 the device identification module comprises a device type identifier module adapted to discover a desired type of the desired device based on the desired parameters (see paragraph bridging columns 6 and 7).

28. Referring to claim 90, Reichmeyer teaches the device identification module comprises a device locator module adapted to identify the desired device via an identifier signal communicated between the desired device and the device locator module (see paragraph bridging columns 6 and 7).

29. Referring to claim 91, Reichmeyer teaches a network address assignment module adapted to assign the network address to the desired device (see paragraph bridging columns 5 and 6).

30. Referring to claim 92, Reichmeyer teaches a network address management server having the network analysis module (see item labeled 24 in figure 3).

31. Referring to claim 93, Reichmeyer teaches the device configuration module comprises a network configuration module

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adapted to configure network parameters for the desired device (see lines 26-47 of column 1).

32. Referring to claims 95-98, Reichmeyer teaches the computing device is headless (see items labeled 62 and 64 in figure 3).

33. Referring to method claims 110,111,114,116, and 117 Watanabe teaches the act of initiating a sensory identification event comprises enabling user interaction with the computing device to activate a unit identification indicator in a graphical user interface of a remote display, wherein enabling user interaction with the computing device comprises providing a button on the computing device (see paragraphs 74-79 bridging pages 4 and 5).

It would have been obvious to combine the teachings of Reichmeyer, Hamner, and Watanabe for the same reasons as mentioned above.

34. Referring to claim 112,113,115,118,119,120, and 121, Hamner teaches the act of initiating a sensory identification event comprises permitting selection of the computing device via a graphical user interface (see Hamner, lines 10-24 of column 4), Watanabe teaches triggering a sensory output from the computing

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device, wherein the sensory output comprises light emissions from the computing device (see paragraph 55 on page 3 and paragraph 60 on page 4).

It would have been obvious to combine the teachings of Reichmeyer, Hamner, and Watanabe for the same reasons as mentioned above.

35. Claims 24,32,54-57,58,81, and 82 rejected under 35 U.S.C. 103(a) as being unpatentable over Reichmeyer in view Hamner and further in view of Watanabe as applied to claims 1,31,33,48,51, and 79 above and further in view of Li et al. (U.S. Patent No. 6,012,088 hereinafter "Li").

36. Referring to system claims 32,54-57, and 81, the combination of Reichmeyer, Hamner, and Watanabe fails to teach the network device comprises a cache server, a file server, an application server, or a web server.

In an analogous system and method, Li teaches remotely configuring devices wherein the devices comprise any variation of a server (see lines 24-67 of column 3).

It would have been obvious to one ordinary skill in the art at the time of the applicant's invention to modify the combination of Reichmeyer, Hamner, and Watanabe with the above

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teachings of Li. One of ordinary skill in the art would have been motivated to make such modification in order to allow customers to easily configure their complex internet accessing devices as suggested by Li (see lines 24-37 of column 3).

37. Referring to method claim 24, and system claims 58 and 82, Reichmeyer teaches the devices are configured over a network (see lines 26-47 of column 1), however the combination of Reichmeyer, Hamner, and Watanabe fails to explicitly set forth the limitation that the network is the Internet.

Li teaches the network is the Internet (see lines 24-67 of column 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Reichmeyer with the above teachings of Li. One of ordinary skill in the art would have been motivated to make such modification in order to be able to configure the device from any location.

38. Claims 3,7,9,10,34,38,40,70,71,73,74,86,88, and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reichmeyer in view of Hamner and further in view of Watanabe as applied to claims 1,33,48,51, and 79 above, and further in view

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of Caswell et al. (U.S. Patent No. 6,336,138 hereinafter "Caswell").

39. Referring to method claims 3,7,9,34, and 38, and system claims 70,71,86, and 94, the combination of Reichmeyer, Hamner, and Watanabe fails to teach searching the network for the device based on desired parameters, wherein the desired parameters comprise a desired network address range and discovering the address assignment of the network device, wherein the configuration module initiates the configuration.

Caswell teaches, in an analogous system and method, the above limitation (see lines 30-42 of column 23).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Reichmeyer, Hamner, and Watanabe with the above teachings of Caswell. One of ordinary skill in the art would have been motivated to make such modification in order to quickly identify and discover all of the devices on the network as suggested by Caswell (see lines 30-42 of column 23).

40. Referring to method claims 10 and 40, and system claims 73,74, and 88, Reichmeyer teaches searching for a desired software application on the device, wherein the software

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application comprises a device management utility (see paragraph bridging columns 6 and 7).

41. Claims 8,39,72, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reichmeyer in view Hamner and further in view Watanabe, and further in view of Caswell as applied to claims 7,38,70, and 86, above and further in view of Morisada et al. (EP 0964546 A2 hereinafter "Morisada").

42. Referring to method claims 8 and 39, and system claims 72 87, the combination of Reichmeyer, Hamner, and Caswell fails to teach the act of searching comprises searching for devices at a desired network port.

Morisada teaches, in an analogous system, the above limitation (see abstract).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Reichmeyer and Caswell with the above teachings of Morisada. One of ordinary skill in the art would have been motivated to make such modification in order to quickly search and retrieve information at physical addresses inherent to network ports as suggested by Morisada (see lines 35-42 of column 4).

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43. Claims 28 and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Reichmeyer in view of Hamner and further in view of Watanabe as applied to claims 1,31,33,48,51, and 79 above and further in view of Tonelli et al. (U.S. Patent No. 6,229,540 hereinafter "Tonelli").

44. Referring to claims 28 and 29, the combination of Reichmeyer, Hamner, and Watanabe fails to teach displaying a list of discovered devices and selecting a desired device to configure and configuring the device.

Tonelli teaches the above limitations (see paragraph bridging columns 20 and 21).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Reichmeyer and Hamner with the above teachings of Tonelli. One of ordinary skill in the art would have been motivated to make such modification to give the user to have control over the configuration process.

45. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reichmeyer in view Hamner and further in view

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of Watanabe as applied to claims 1,31,33,48,51, and 79 above and further in view of Pike (U.S. Patent No. 6,721,880).

46. Referring to claim 37, the combination of Reichmeyer, Hamner, and Watanabe fails to teach verifying an authorization criteria for configuring the desired device; and assigning a network address to the desired device having the authorization criteria verified.

Pike teaches, in an analogous method the above limitation (see lines 11-25 of column 2).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Reichmeyer, Hamner, and Watanabe with the above teachings of Pike. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to ensure only authorizes personnel are able to make configuration changes as suggested by Pike (see lines 11-25 of column 2).

47. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reichmeyer in view of Hamner in view of Watanabe as applied to claims 1,31,33,48,51, and 79 above, and

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further in view of Bonasia et al. (U.S. Patent No. 6,901,439 hereinafter "Bonasia").

48. Referring to claim 18, the combination of Reichmeyer and Hamner fails to teach the act of initiating an identification event comprises the act of communicating an identification signal from a remote interface to the computing device via the network.

Bonasia teaches, in an analogous system, the above limitation (see paragraph bridging columns 5 and 6).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Reichmeyer and Hamner with the above teachings of Bonasia. One of ordinary skill in the art would have been motivated to make such modification in order provide a means for a user to add equipment to a network in a relatively simple manner as suggested by Bonasia (see lines 28-33 of column 3).

Response to Arguments

49. The declarations filed on 4/28/06 under 37 CFR 1.131 has been considered but is ineffective to overcome the Wantanabe reference (US Pub. No. 2002/0062364).

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50. After careful examination of the declarations and accompanying exhibits, it appears as if the applicant is attempting to establish prior invention by showing actual reduction to practice before the effective date of the Wantanabe reference (4/3/01).

51. Per MPEP 715.02,

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it. In re Tanczyn, 347 F.2d 830, 146 USPQ 298 (CCPA 1965) (Where applicant claims an alloy comprising both nitrogen and molybdenum, an affidavit showing applicant made an alloy comprising nitrogen but not molybdenum is not sufficient under 37 CFR 1.131 to overcome a rejection under 35 U.S.C. 103 based on the combined teachings of one reference disclosing an alloy comprising nitrogen but not molybdenum and a second reference disclosing an alloy comprising molybdenum but not nitrogen). Note, however, where the differences between the claimed invention and the disclosure of the reference(s) are so small as to render the claims obvious over the reference(s), an affidavit or declaration under 37 CFR 1.131 is required to show no more than the reference shows. In re Stryker, 435 F.2d 1340, 168 USPQ 372 (CCPA 1971). In other words, where the examiner, in rejecting a claim under 35 U.S.C. 103, has treated a claim limitation as being an obvious feature or modification of the disclosure of the reference(s) relied upon, without citation of a reference which teaches such feature or modification, a 37 CFR 1.131 affidavit or declaration may be sufficient to overcome the rejection even if it does not show such feature or modification.

Even if applicant's 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of applicant's 37 CFR 1.131 evidence, prior to the effective date of the reference(s) or the activity. Such evidence is sufficient because applicant's possession of what is shown carries with it possession of variations and adaptations which would have been obvious, at the same time, to one of ordinary skill in the art. **However, the affidavit or declaration showing must still establish possession of the invention (i.e., the basic inventive concept) and not just of what one**

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reference (in a combination of applied references) happens to show, if that reference does not itself teach the basic inventive concept. In re Spiller, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974) (Claimed invention was use of electrostatic forces to adhere dry starch particles to a wet paper web on the Fourdrinier wire of a paper-making machine. 37 CFR 1.131 affidavit established use of electrostatic forces to adhere starch particles to wet blotting paper moved over a fluidized bed of starch particles prior to the applied reference date. Affidavit was sufficient in view of prior art reference showing that deposition of dry coatings directly on wet webs on the Fourdrinier wire of a paper-making machine was well known in the art prior to the date of the applied reference. The affidavit established possession of the basic invention, i.e., use of electrostatic forces to adhere starch to wet paper.).

Applicant may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date. **However, as discussed above, applicant's 37 CFR 1.131 affidavit must show possession of either the whole invention as claimed or something falling within the claim(s) prior to the effective date of the reference being antedated;** it is not enough merely to show possession of what the reference happens to show if the reference does not teach the basic inventive concept.

52. Per MPEP 715.07,

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, "there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." In re Asahi /America Inc., 68 F.3d 442, 37 USPQ2d 1204, 1206 (Fed. Cir. 1995) (Citing Newkirk v. Lulejian, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and Sachs v. Wadsworth, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to

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practice.).

The facts to be established under 37 CFR 1.131 are similar to those to be proved in interference. The difference lies in the way in which the evidence is presented. If applicant disagrees with a holding that the facts are insufficient to overcome the rejection, his or her remedy is by appeal from the continued rejection.

53. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Wantanabe reference. While the declarations and accompanying exhibits show the basic concepts of the invention, *the evidence submitted does not show the entire claimed invention* (emphasis added) .

Claim 6 requires the act of responding to the address request comprises the acts of verifying a desired characteristic of the computing device and assigning a network address to the computing device. The exhibits show assigning a network address to the computing device, however, it is unclear to the examiner where in the declaration or exhibits the limitation of verifying a desired characteristic is demonstrated.

Claims 11-15 require the act of identifying the computing device comprises the act of discovering a desired device characteristic, wherein discovering the characteristics,

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comprise discovering the device category, the device source, the device manufacturer, and the device model. These limitations do not appear to be shown in the evidence provided.

The claims identified above are not intended to be a complete listing of claims in which evidence of actual reduction to practice is insufficient. The applicant is encouraged to review all pending claims and identify where each claim limitations is shown in the declaration and/or the accompanying exhibits.

Conclusion

54. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J. Sorrell whose telephone number is 571 272-4160. The examiner can normally be reached on Monday-Friday 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on 571-272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


KIM HUYNH
SUPERVISORY PATENT EXAMINER

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